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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,266	09/18/2006	Satoru Banzai	1009682-000163	6449

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EXAMINER
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KENNEDY, NICOLETTA

ART UNIT	PAPER NUMBER
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1611

NOTIFICATION DATE	DELIVERY MODE
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02/01/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
offserv@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,266	<b>Applicant(s)</b> BANZAI, SATORU	
	<b>Examiner</b> Nicoletta Kennedy	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/14/09</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

The amendments and remarks dated August 14, 2009 are acknowledged. Claims 8-20 are currently pending. Claims 1-7 have been canceled and claim 20 has been added. Claim 19 is withdrawn as drawn to a non-elected invention.

### ***Priority***

This application, filed September 18, 2006, is a national stage entry of PCT/JP05/02784, filed February 22, 2005, and claims foreign priority to Japanese application 2004-074665, filed March 16, 2004. The International Bureau has provided a certified copy of the Japanese application.

### ***Withdrawn Rejections***

1. The rejection of claims 7-18 under 35 U.S.C. 102(b) as being anticipated by Nishihama et al. (US 6,358,395) (pub. Mar. 19, 2002) as evidenced by Encarta® World English Dictionary [North American Edition] © & (P) 2009 is withdrawn in light of Applicant's amendments.

### ***New Rejections Necessitated by Amendment***

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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**2. Claims 8-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishihama et al. (US 6,358,395) (pub. Mar. 19, 2002) as evidenced by Encarta® World English Dictionary [North American Edition] © & (P) 2009.**

Regarding claims 8-18 and 20, the cosmetic stick of the pending claims has been described in U.S. Patent 6358495 (hereafter the 495 patent). Claim 20 is a product-by-process claim. "The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (The claims were directed to a zeolite manufactured by mixing together various inorganic materials in solution and heating the resultant gel to form a crystalline metal silicate essentially free of alkali metal. The prior art described a process of making a zeolite which, after ion exchange to remove alkali metal, appeared to be "essentially free of alkali metal." The court upheld the rejection because the applicant had not come forward with any evidence that the prior art was not "essentially free of alkali metal" and therefore a different and unobvious product.).

Note that the determination of patentability of a product is based on the product itself, and not its method of production, and so the process described in pending claim

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20 has not been considered in this rejection. Lines 37-39 of column 2 of the 495 patent disclose that the titanium silica complex of the title is a mesoporous material as per pending claim 20. Note that silica is a ceramic as per pending claim 8 and the titanium constitutes the metal of pending claim 9. The paragraph of line 51 column 9 discloses extender materials to be used with the titanium silica complex as per pending claim 20. Note that the extender material mica is disclosed in Formulation Example 4 of the 495 patent (column 12), and that this example also includes the mesoporous titanium-silica complex, and is a stick type cosmetic. Note that the pore ranges of pending claims 10-12 are not actually further limiting the product, because a mesopore is defined as a pore with a diameter of 2-50 nm (see definition in Encarta® World English Dictionary [North American Edition] © & (P) 2009). The paragraph of line 11 of column 10 of the 495 patent discloses an embodiment which is a cosmetic pencil as per pending claims 13-18. This cosmetic pencil is one of only 5 forms disclosed by the 495 patent and so one would immediately envisage a cosmetic pencil based on this disclosure.

### ***Response to Arguments***

3. Applicant's arguments filed August 14, 2009 have been fully considered but they are not persuasive. Applicant argues that the instant invention differs from that of Nishihama et al. as evidenced by Encarta® World English Dictionary [North American Edition] © & (P) 2009 because the instant invention has unexpected results over Comparative Example 4. This argument is not persuasive because evidence of

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secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). See MPEP 2131.04.

4. Applicant's also argue that Nishihama et al. produce a mesoporous powder in advance and then mix it with other ingredients. However, claim 20 is a product-by-process claim. As explained above, the process of making a composition claim is not given patentable weight until differences are shown between the two products that substantiate that a different product was been made. Further, the language of claim 20 does not require that the extender material is bound as a skeleton, just that an extender material and a mesoporous material are present in the stick type cosmetic. As explained above, Nishihama et al. teach a stick type cosmetic comprising an extender material and a mesoporous material and therefore anticipate claim 20.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicoletta Kennedy whose telephone number is (571)270-1343. The examiner can normally be reached on Monday through Thursday 8:15 to 6:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Gollamudi Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. K./

Examiner, Art Unit 1611

/David J Blanchard/

Primary Examiner, Art Unit 1643